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09/973,031	10/09/2001	Dale F. McIntyre	83194F-P	5074

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/973,031
Filing Date: October 09, 2001
Appellant(s): MCINTYRE ET AL.

Frank Pincelli

For Appellant

EXAMINER'S ANSWER

MAILED

JUN 30 2005

Group 3700

This is in response to the appeal brief filed on April 14, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 4-6, and 8-12 (Group I), Claims 3, 32, 33 (Group II) and Claim 7 (Group III) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

370,186	G. W. FOUNTAIN	9-1887
6,061,938	YOUNG	5-2000
3,848,348	HAWLEY	11-1974

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 33 is rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior office action mailed on August 25, 2004.

Claims 1, 3-6, 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain. This rejection is set forth in prior office action mailed on August 25, 2004.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain in view of Young. This rejection is set forth in prior office action mailed on August 25, 2004.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain in view of Hawley. This rejection is set forth in prior office action mailed on August 25, 2004.

(11) Response to Argument

Appellant's arguments filed on April 14, 2005 have been fully considered but they are not persuasive.

In response to the objection to the drawings, the examiner has withdrawn the drawing objections and has approved the drawings.

In response to Claim 33, the examiner has withdrawn the 35 U.S.C. 112, First Paragraph Rejection, wherein Claim 33 now contains allowable subject matter.

In response to Issue 1 (Claims 1, 2-6, and 8-12), the appellant states that the Fountain reference does not teach or suggest providing a plurality of images on an

album leaf assembly. The examiner submits that Fountain discloses wherein the outer leaf of the first or second ply has at least one image or images (photo seen in Fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Furthermore, Fountain discloses in Col. 1, lines 10-12, "a means whereby a short biographical record may be preserved in connection with the photograph. Webster's Dictionary defines "biographical" as "relating to an account of the life of something. In its broadest sense, the "life of something" can either be a single person as shown in the figures, or it can be a group, an organization, a team, etc..., which contains a number of people (plurality of images) which form a single unison of an embodiment ("something"). Therefore, it would be obvious to modify the Fountain leaf to include as many images as desired by the end user to show additional displayed indicia (whether it is one photograph having a plurality of images (such as a sports team), or two separate photographic images (the Wright Brothers, who invented the first airplane).

In response to appellant's argument that the Fountain reference does not disclose wherein the information provided on the insert is located such that the information is readily identified with respect to the plurality of images it is associated and that the information has a reduced size of the associated image with reduced visual characteristics, the examiner submits that Fountain does indeed disclose an insert (10)

having a size and configuration so that it can be placed within the pocket, and wherein insert has information relating (gives account of the life of the image shown) to the image on the album leaf, and is located in a position such that it can be readily identified (the information can be identified when tab (12) is pulled upon by the end user) with respect to the associated image on the album leaf. Note, since appellant has not defined the metes and bounds of what is meant by "readily identified", the examiner has examined the claim in its broadest sense, that the information can be readily identified when the insert has been pulled out. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any type of imaged indicia or information indicia on the plies' outer surface and on the restrained insert, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter (information) is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content (a size provision and a second image) of the printed matter placed on the substrate (insert and ply) may render it more convenient by providing an individual with a specific type of form assembly does not alter the functional relationship. Mere support by the substrate (insert and plies) for the printed matter (images and information) is not the kind of functional relationship necessary for patentability. Thus, there is no novel an unobvious functional relationship between the printed matter and the substrate, which is required for patentability. Further, it would have bee obvious to form the information in any

desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, the indicia information placed on the insert can be of any desirable size, since appellant has not disclosed the criticality of having a particular sized of indicia dimensions.

In response to appellant arguments that the prior art of Young does not disclose a folded insert retained in a pocket, the examiner submits that Young does indeed disclose a foldable insert (32) having "shoulder-engaging extensions" (50) to retain the insert in the pocket. Although the insert is not entirely retained in the pocket, portions of the insert are indeed retained as shown in Fig. 2.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Mark Henderson
Examiner in Art unit 3722
June 27, 2005

Conferees



Derris Banks
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